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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/502,256

07/23/2004

Takehiko Kitamori

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05/15/2006

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EXAMINER

LUM, LEON YUN BON

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/502,256

Applicant(s)

KITAMORI ET AL.

Examiner

Leon Y. Lum

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 20-21.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.



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05/10/06

Continuation of 11. does NOT place the application in condition for allowance because of the following two reasons:

(1) Claim 20, drawn towards an enzyme immunoassay chip, has been amended to include an intended use limitation that does not further limit an apparatus claim. The rejection applied in the previous Office Action therefore still applies. On page 7, line 3, of the Remarks, filed April 10, 2006, Applicants contend that the structure of Harrison reference differs from that of the claimed invention. However, the following statements in lines 4-21 supporting the contention is directed towards a process of using the structure and does not actually provide an argument against any structural differences that would bear relevance on an apparatus claim. On page 7, last paragraph spanning page 8, first paragraph, Applicants again state that the structure in Harrison reference is different from that of the claimed invention. However, Applicants' recital of the Harrison's structural components and a lack of rationale for the alleged difference fail to provide a convincing argument.

Furthermore, Applicants seem to have misunderstood the obviousness rejection of the previous Office Action as evidenced by the statement "The secondary references of Eteshola and Sato fail to provide a suggestion to improve upon the structure of the micro channel in Harrison by cancelling the weir (6) at on a stream side". See page 8, 2nd-3rd paragraphs. The previous Office Action never made a statement regarding any "cancelling" of structural components taught by Harrison. In fact, Eteshola and Sato references were combined with Harrison to teach the limitations of (1) an enzyme reaction produce produced by antigen antibody reaction with an enzyme, and (2) detection by a thermal lens microscope system, as recited in the method steps of claim 21 and not the chip of claim 20. The motivation for combining the two secondary references with Harrison is clearly stated and does not mention any alteration of Harrison's structure. See pages 5-6 of the previous Office Action. Applicants are directed to pages 3-4 of the previous Office Action, which clearly explain how the structural components of Harrison reference apply to each of the claimed components of the instant invention.

Lacking convincing arguments in the Remarks filed April 20, 2006 directed towards claim 20, the instant claim is not in condition for allowance and remains finally rejected.

(2) Applicants have amended claim 21, drawn towards an enzyme immunoassay method, to include the limitations of "a majority of enzyme reaction products" and "detected by a thermal lens microscope system in the detection flow passage part so as to produce increased signal strength." Although these limitations add terms to the instant claim, they do not overcome the applied prior art. On page 7, 5th paragraph, Applicants argue that the beads in Harrison reference do not contribute to the added limitation of "increase of signal strength" because "the majority of elution of the fluorescent labeled reagent does not reach to detector" and "the majority of beads do not reach the detector as in the present invention." However, it is noted that the instant claim never requires the beads to actually reach the detector. In fact, in line 9 of claim 21 recites the limitation "thereby stop the flow of bead-bodies through the reaction flow passage part", which clearly indicates that the claimed invention does not have the beads flow to the detector as argued by Applicants. With respect to Applicants' argument of "increased strength" and "fluorescent labeled reagent does not reach to detector", Applicants are directed to column 18, lines 2-7, which recite that an elution solvent is introduced to deliver a "concentrated protein digest" to collection area 40, which has been applied in the previous Office Action as the claimed "detector". Harrison reference therefore provides a clear teaching that the reagents do reach the detector in concentrated form, which also teaches the claimed "increased signal".

On page 8, 5th paragraph, Applicants argue that with regards to claim 21, Harrison fails to disclose or suggest that the enzyme reaction product is produced by antigen antibody reaction with an enzyme. Applicants are once again directed to pages 5-6 of the previous Office Action, which clearly states that Harrison does in fact fail to teach this limitation, but is combined with Eteshola and Sato references to produce a proper obviousness rejection to teach the limitation. It is improper to argue against references individually when they are applied in a combination towards an obviousness rejection.

Since it has been established that the obviousness rejection meets all the limitations of claim 21, including the newly added limitations, and Applicants' arguments are not convincing, the instant claim is not in condition for allowance and remains finally rejected.



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